

REMARKS

Claims 2, 3, 5-8, 10, 13, 16, and 18-38 are pending. Claims 16, and 32-38 stand rejected under 35 U.S.C. 112, paragraph first. The others are currently withdrawn. Reconsideration and reversal of the instant rejections are hererby earnestly solicited for the reasons set forth below, *inter alia*.

I. Rejection of Claims as Failing to Comply With the Written Description Requirement of 35 U.S.C. § 112

Claim 16 stands rejected under 35 U.S.C. § 112 for lack of antecedent basis for the claim "stablizer." An amendment to claim 16 is hereby introduced that the Applicant respectfully believes will render the Examiner's rejection moot.

II. Rejection of Claims Under 35 U.S.C. § 102

Claims 32 and 34-38 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,335,026. To overcome an anticipation rejection, the Inventors need only demonstrate that the references fail to teach each and every claimed limitation. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

The Examiner correctly points out the similar limitations of the instant invention and that of the '026 patent. Both provide a composition having ethylene-propylene-diene monomer and an elastomeric stabilizer. However, the Inventor's disclosure performs its function without the same quantity of rubber as disclosed in the '026 patent. *See Col. 2, lines 19-33*. Unfortunately, the Inventors did not clearly explain in the specification why their composition comprised inherent characteristics different from compositions such as the '026 composition. However, paragraphs [0006]-[0013] of the Inventor's specification was an attempt to explain why the present composition is superior and improvement upon the others in the art. Minus these inherent characteristics of the Inventor's invention, which are not found in the composition of the '026 patent, the Examiner's conclusions would be accurate.

The '026 patent limitation comprise an about 25% to about 42% by weight composition of **an elastomeric blend**. The elastomeric blend is made up of (1) a rubber and (2) a terpolymer, such as ethylene-propylene-diene monomer. **The ratio of rubber to terpolymer** is between 7.5:1 and 2:1.

Consequently, the Inventor's invention and the invention of the '026 patent are not identical as required by *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989). The Examiner cites the '026 patent in concluding that the Inventor's disclosed 3:1 ratio of ethylene to propylene is anticipated. However, **the ratio disclosed in the '026 patent is that of ethylene-propylene-diene monomer to rubber, not ethylene to propylene**. Thus, every claimed limitation is not disclosed and the inventions are therefore not the same.

As a matter of note, the Inventors respectfully would like to bring to the Examiner's attention that that use of the term "rubber" in the '026 patent is not enabling insofar as it applies to the present case. As the Examiner is likely aware, rubbers form a class of elastic hydrocarbon polymers that occur naturally or can be produced synthetically. In fact, rubber technology forms an entire field of study. To that end, claiming a mixture of EPDM and "rubber" is non-enabling insofar as it doesn't specifically refer to any genus of rubbers that perform a specific function. As shown by the tables in the present disclosure, the combination of EPDM and various "rubbers" and other constituents show a considerable range of effectiveness for the intended functions, and these results are only a carefully controlled and very small subset of all permutations of EPDM with rubber.

The Inventors therefore respectfully point out that the anticipation rejection based on the first paragraph of the Detailed Description of the '026 patent is made based on a non-enabled description that encompass nearly any adhesive composition having any blend of EPDM with another rubber. As a matter of public policy, rejection of improvements in the field with such a broad and non-enabled description eliminates any incentives to continue development in this field and seek improved functionality, as was done by the Inventors. Indeed, rejection with such a broad and all encompassing

description is akin to rejecting improvements in car door technology simply because somebody disclosed in prior patent a car having a car door.

Finally, the Examiner might assume *arguendo* that the Inventor's invention could be deemed to be a derivative of that disclosed in the '026 patent. Assuming that to be the case, *arguendo*, the '026 composition, due to the large component rubber (e.g., natural rubber) (*Col. 2, lines 23-26*), and the Inventor's invention that does not require the same "rubber component" (*Col. 2, line 24*) are patentably distinct compositions because they have inherently different fundamental compositions (i.e., they are different recipes), rendering them different inventions per se. The Inventor's invention is therefore not simply a derivative of the composition of the '026 patent.

The Inventors respectfully submit that, although the Examiner is correct that the '026 patent is a similar composition to the present composition, it is a fundamentally and inherently different composition and the rejection should be withdrawn or in the alternative is traversed. As the dependent claims stand or fall with the independent claim, the same arguments therefore apply and are incorporated by reference for each rejected dependent claim.

III. Rejection of Claims Under 35 U.S.C. § 103

A. Joint Inventors

The Examiner reminded the inventor of the duty of full disclosure under 37 C.F.R. § 1.56 and the Inventors are thus reminded of the duty to disclose all information material to patentability to the Examiner.

B. Rejection of Claim 16

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being obvious over US '026 in view of US 5,750,134.

The Court of Appeals for the Federal Circuit has made clear that "hindsight" rejections are improper. In *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929 (Fed. Cir. 1984), the Federal Circuit reversed a holding of invalidity

because there was no teaching to combine the references. Similarly, the Federal Circuit, in *W.L. Gore Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983), referenced the "insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher, and condemned this type of rejection or holding of unpatentability."

According to the United States Supreme Court, the Examiner must consider secondary considerations (Graham factual inquiries) in the Examiner's *prima facie* case of obviousness. See *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969). In light of the secondary considerations, the Inventors respectfully submit that the Examiner's obviousness rejections are based on impermissible hindsight.

The Inventors concede the difficulty in determining obviousness in crowded fields of art. In the instant case, however, combining the teachings of the '026 patent with that of the '134 patent constitutes impermissible hindsight because the addition of an elastomeric component to an EPDM composition was a long felt but unresolved need in the art.

The '026 patent was applied for in 1981. Fourteen years later, the '134 patent was filed for and disclosed a method of delivery of agents, comfort, and lack of cold flow when stored at room temperature, by adding an agent such as butyl rubber. It was not until 7 years after the '134 patent was filed, and over 20 years after the '026 patent was filed that an inventor posited the idea of combining EPDM and a method of delivery of agents, comfort, and lack of cold flow in the present disclosure. Thus, a long standing need was addressed by the present invention which was likely inadvertently overlooked by the Examiner.

Naturally, application of the subject matter of the '134 patent would seem obvious after reading the Inventor's disclosure. However, the Inventors respectfully submit that absent their disclosure, the combination of EPDM and the subject matter of the '134 patent, **taken as a whole**, would still be undisclosed.

Hence, the combination of the composition of the present disclosure addresses a long felt yet unresolved need, and the resulting obviousness rejection should be withdrawn as it constitutes impermissible hindsight.

C. Rejection of Claim 33

Claim 33 stands similar rejected as obvious over US '026 in view of US 6,805,961. However, the same argument with respect to impermissible hindsight exists in this case as in the rejection of Claim 16, and those arguments are incorporated by reference to the rejection of claim 33. Although it is suggested that the '026 patent recognizes the addition of an elastomer to the composition comprising EPDM and although '961 subject matter discloses an amorphous propylene based polyolefin, the combination of the Inventor's disclosure taken as whole was never disclosed and addressed a long standing yet unresolved need.

Indeed, the Inventor respectfully points out that Examiner cites the usefulness in exchanging propylene for amorphous propylene (*See page 6, paragraph 1 of Office Action*). However, the Inventor also respectfully submits that without an explanation provided as to why the need for an improved elastomer used in conjunction with EPDM was never disclosed prior to the teachings of the Inventor's application, the rejection is based on impermissible hindsight. Thus the obviousness rejections are hereby traversed.

Moreover, the obviousness rejections, as detailed above, are respectfully traversed because each of applicants' stabilizer (claim 16) and applicants' ethylene propylene elastomer (claims 32 - 38) render the subject matter patentable, as expressly stated in the revised claims. Tables 1 and 2, at pages 7 - 9 of applicants' specification, respectively show why these respective formulation choices, far from being obvious, actually were tested and chosen for better adhesion to the skin, better saline absorption and a higher degree of mechanical integrity.

The prior art fails to disclose combinations used to achieve better fluid absorption, *without compromising other aspects of the design* that can likewise function with respect to adhesion and other medical needs. Accordingly, the instant

subject matter should be passed to issuance and allowance and such relief is hereby earnestly solicited.

CONCLUSION


Applicants have complied with all requirements made in the above-referenced communication. Should any matters remain that the Examiner believes could be resolved in a telephone interview, the Examiner is respectfully requested to telephone the Applicants' undersigned agent and propose an interview between Feb. 1 and May 1, 2007. 37 CFR 1.333.

This response is being timely filed and no fee is believed due. However, if Applicants are mistaken, the Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that Attorney Docket Number 70377-010200 is referred to when charging any payments or credits for this case.

Respectfully submitted,

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